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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,911	06/05/2001	David J. Sagar	47524/P120US/10023619	3595

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DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.  
2200 ROSS AVENUE  
SUITE 2800  
DALLAS, TX 75201-2784

EXAMINER

SHERR, CRISTINA O

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/874,911	<b>Applicant(s)</b> SAGAR ET AL.	
	<b>Examiner</b> Cristina Owen Sherr	<b>Art Unit</b> 3621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 October 2004.  
 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-70 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-70 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This communication is in response to the amendment filed October 27, 2004.

Claims 1-70 are pending in this case.

### ***Response to Arguments***

2. Applicant's arguments filed October 27, 2004 have been fully considered but they are not persuasive. Applicant argues that Katz does not disclose a system and method for the reducing fraud in pre-paid phone systems. Attention is directed to Katz (Us 6,424,706) at col 4 ln 38-56. Applicant further argues that In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 1-4, 27-35 and 62-70 are rejected under 35 U.S.C. 102(e) as being anticipated by Katz et al (US 6,424,706B1).

5. Regarding claims 1-4, 27-35 and 62-70 –

Katz discloses a system and method for reducing fraud in pre-paid phone systems such that the users have a computer system including prepaid platform adapter for interfacing with a prepaid platform, a financial network adapter for interfacing with a financial network an interface to said prepaid system, wherein said prepaid system accounts for subscriber account credits and subscriber account debits to thereby determine a subscriber prepaid balance for use in operating said prepaid system, wherein said prepaid system interface accepts prepaid account credit information from said prepaid system; an interface to a service system, wherein said service system interface accepts information with respect to services provided; and control logic utilizing said prepaid account credit information accepted through said prepaid system interface and said information with respect to services provided accepted through said service system interface to thereby determine a fraud detection subscriber account balance, wherein said control logic utilizes said fraud detection subscriber account balance to determine a fraud condition in an associated subscriber account independent of said determination of said subscriber prepaid balance by said prepaid system. (e.g. col 4 ln 38-56).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-26, and 36-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al (US 6,424,706B1) in view of Osmani et al (5,815,807A) further in view of Morgan (US 6,064,875A).

8. Regarding claims 4-20, and 36-58 –

Katz does not disclose, but Osmani discloses prepaid calling system stores secure prepaid credit values for a plurality of subscribers in a centralized memory, refill information includes a refill amount and time information with respect to said refill amount, in a wireless system, where fraud condition determination is made at least in part through comparison of said fraud detection subscriber account balance to a predetermined threshold value fraud condition determination is made at least in part through comparison of said fraud detection subscriber account balance to a predetermined threshold value (e.g. col 3 ln 64-col 4 ln 42).

9. Regarding claims 21-26 and 59-61 –

Katz and Osmani do not disclose but Morgan discloses a wireless communications system where fraud condition determination is made at least in part through comparison of subscriber account balance to a first predetermined threshold value, and wherein the second fraud condition determination is made at least in part through comparison of the fraud detection subscriber account balance to a second predetermined threshold value, wherein the said first predetermined threshold value is greater than the second predetermined threshold value; associated with a suspicion of fraud and said second

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fraud condition is associated with a conclusion of fraud; notification transmitted to said prepaid system by said fraud detecting system, and wherein said second response includes information with respect to subscriber activity suspension transmitted to said service system (e.g. col 2 ln 57 – col 4 ln 15).

10. It would be obvious to one of ordinary skill in the art to combine the teachings of Katz, Morgan and Osmani in order to obtain greater security with greater efficiency in wireless communication.

11. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Chasek (US 5,809,480) discloses an automated secure interauthority settlement system and method for electronic toll collection.

**14. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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15. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

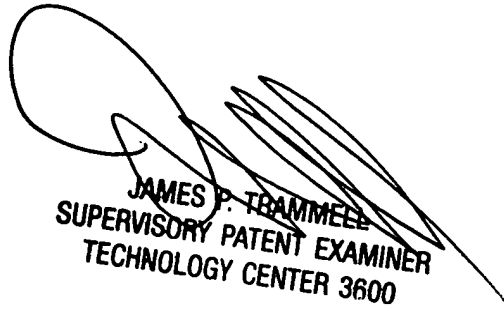
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 703-305-0625. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600